

REMARKS

In the Office Action, the Examiner restricted claims 1-9, 11-30, 32-46, and 48-94 to one of the following groups. Specifically, the Examiner provided the following groups: (Group I) claims 1-9, 11-30, 32-40, and 79-94 drawn to a method for processing images produced by medical diagnostic imaging system, classified in class 382, subclass 128; (Group II) claims 41-46 and 48-78 drawn to a method for performing a comparative analysis of a plurality of images, classified in class 382, subclass 218. The Examiner also stated:

Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as comparative analysis of plurality of images. See MPEP § 806.05(d).

Office Action mailed on January 19, 2006, page 2 (emphasis added).

In accordance with 37 C.F.R. § 1.143, the Applicants elect to prosecute claims 1-9, 11-30, 32-40, and 79-94 of Group I *with traverse*. After careful review of the Examiner's restriction requirement, the claims, the file history, and the Manual of Patent Examining Procedure, the Applicants believe that the Examiner's restriction requirement is improper and must be withdrawn. As discussed below, the Applicants believe that the *overlap in scope* between claims, the lack of *serious burden* to examine all claims, and the policy against *piecemeal* examination require that the Examiner withdraw the restriction requirement and examine all pending claims.

First, the Examiner's restriction requirement is improper due to the overlapping scope of claims in Groups I and II. The Manual of Patent Examining Procedure specifically states:

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are

usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.

M.P.E.P. (Rev. 3, August 2005) § 806.05(d) (emphasis added). The Examiner's restriction requirement does not appear to meet the "do not overlap in scope" criteria set forth above. For example, the independent claims 1 and 59 recite, *inter alia*, a "uniform interface" and "highlight temporal differences." By further example, the independent claim 26 similarly recites, *inter alia*, a "uniform interface," "geometrically matching the desired *physiological* features ... of *temporally* distinct medical diagnostic images," and "*highlight* physiological differences." Similarly, the independent claim 41 recites, *inter alia*, a "uniform interface" and "*temporal* analysis image illustrating *physiological* differences." Finally, the independent claim 79 recites, *inter alia*, "*temporal* image analysis" and "geometrically matching desired *physiological* features in at least two images obtained over a time period." As indicated by these claim recitations among others, the independent claims have many commonalities and generally overlap in claim scope. The Applicants acknowledge the Examiner's assertion that the "invention II has separate utility such as comparative analysis," yet the Applicants believe this statement to be unreasonable in view of the common/similar claim recitations noted above. Office Action mailed on January 19, 2006; *see* M.P.E.P. (Rev. 3, August 2005) § 806.05(d). For these reasons among others, the Examiner's restriction requirement is improper and cannot stand.

Second, the Applicants object to the Examiner's restriction requirement on the ground of a lack of "serious burden" on the Examiner. As set forth in the Manual of Patent Examining Procedure, the criteria for an election requirement includes: (1) the inventions must be independent or distinct, and (2) there must be a serious burden on the Examiner. *See* M.P.E.P. (Rev. 3, August 2005) §§ 802.02 and 803. In this case, the Applicants stress that the prosecution history evidences no burden, much less a "serious burden," on the Examiner.

For example, during the course of prosecution of the present application, the Examiner evaluated original and amended claims, performed prior art searches, formulated rejections, and considered the Applicants' arguments without any indication of a burden. In other words, the Examiner's *continuing* examination of the original and amended claims will not be any additional burden, much less a "serious burden," because most of the claim features have already been subject to examination. Therefore, the Applicants believe that the Examiner's restriction requirement is improper and cannot stand. Again, the Applicants stress that:

If the search and examination of all the claims in an application can be made *without serious burden*, the examiner *must* examine them on the merits, even though they include claims to independent or distinct inventions.

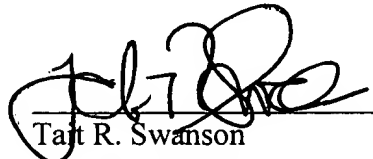
M.P.E.P. (Rev. 3, August 2005) § 803. For these reasons among others, the Applicants respectfully request that the Examiner withdraw the restriction requirement and examine all pending claims.

Third, with reference to the Manual of Patent Examining Procedure, the Applicants also emphasize that "[p]iecemeal examination should be avoided as much as possible." M.P.E.P. (Rev. 3, August 2005) § 707.07(g). Moreover, "the examiner should never overlook the importance of his or her role in allowing claims which properly define the invention." *Id.* at § 706. Over the course of prosecuting the present application, the Applicants have clarified the claims by way of amendments and statements, which clearly indicate the deficiencies of the prior art. In view of the instant restriction requirement, it also appears that the Examiner is delaying prosecution and attempting to force unreasonable piecemeal examination, rather than addressing the Applicants' previous amendments and remarks. For these reasons among others, the Applicants respectfully request the Examiner to withdraw the restriction requirement, carefully review the claims and the prior art, and allow the pending claims.

If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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